

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the amendments and remarks herein, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-19 and 21-22 are currently pending. Claims 1, 3-5, 10, 13, 16, and 21-22, which are independent, are hereby amended. Support for this amendment is provided throughout the Specification as originally filed, and, for example, in the Published Application pars. [0003]-[0004].

No new matter has been introduced by this amendment. Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. 103

Claims 1-4 and 16-22 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0046407 to Franco (hereinafter, merely "Franco") in view of U.S. Patent No. 6,536,041 to Knudsen (hereinafter, merely "Knudsen").

Claims 5-15 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Franco in view of Knudsen and further in view of U.S. Patent No. 6,704,929 to Ozer et al. (hereinafter, merely "Ozer") and also under Official Notice.

Applicants respectfully traverse these rejections.

Claim 1 recites, *inter alia*:

“...display control means for controlling the displaying of said advertisement-associated data received by said receiving means to force the display of said advertisement-associated data as a function of the keyword data and said television program substantially at same time to force a viewer to playback said advertisement-associated data while simultaneously playing back said television program.” (Emphases added)

Applicants respectfully submit the combination of Franco, Knudsen, and Ozer does not teach the above-recited feature of claim 1 and that the applied combination teaches away from the claimed invention.

The cited portions of Franco and Knudsen do not disclose or suggest, “display control means for controlling the displaying of said advertisement-associated data received by said receiving means to force the display of said advertisement-associated data as a function of the keyword data and said television program substantially at same time to force a viewer to playback said advertisement-associated data while simultaneously playing back said television program.” as recited in claim 1.

Furthermore, Applicants respectfully submit that MPEP §2141.02 (VI) states that

“A prior art reference must be considered in its entirety, i.e., as a whole, **including portions that would lead away from the claimed invention.** *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).” (Emphasis added)

Applicants contend both Franco and Knudsen teach away from forcing the display of the advertisement-associated data. Indeed, both Franco and Knudsen are devices that provide the viewer with control of the display of the advertisement-associated data. That is, neither Franco nor Knudsen forces the viewer to display the advertisement-associated data substantially at the same time as the associated television program.

In the Franco apparatus “[t]he user can then watch the commercial at a convenient time rather than when the commercial happens to be broadcast. Moreover, Franco states that “viewers can avoid watching commercials that are not of interest.” Franco, Pub. Appl. par. [0133]. Both statements of Franco clearly teach away from “forc[ing] the display of said advertisement-associated data . . . and said television program substantially at same time to force a viewer to playback said advertisement-associated data while simultaneously playing back said television program,” as recited in claim 1.

Similarly, as understood by Applicants, Knudsen teaches a device wherein a user controls a controllable ticker to display various data. Knudsen teaches, in relevant part, the user can control the content and location of the controllable ticker. Knudsen, col. 13, line 55 to col. 14, line 37 and col. 14, line 60 to col. 15, line 14. The Knudsen device “allow[s] the user to cancel the display of the controllable ticker . . .” Knudsen, col. 15, line 54 to col. 16 line 5.

Thus, neither Franco nor Knudsen “force the display of said advertisement-associated data . . . and said television program substantially at same time to force a viewer to playback said advertisement-associated data while simultaneously playing back said television program, as recited in claim 1. Indeed, both Franco and Knudsen teach a device in which the user controls the display of the advertisement-associated data.

Ozer does not add the element missing from Franco and Knudsen

For reasons similar, or somewhat similar, to those described above with regard to independent claim 1, independent claims 3-5, 10, 13, 16, and 21-22 are also patentable.

III. REJECTIONS OF CLAIMS UNDER OFFICIAL NOTICE

Claims 6-7, 11-12, 14-15 and 17-18 were rejected under Official Notice.

APPLICANTS CHALLENGE THE FACTUAL
ASSERTIONS AS NOT PROPERLY OFFICIALLY
NOTICED OR NOT PROPERLY BASED UPON
COMMON KNOWLEDGE.

In Applicants' January 25, 2007 reply to the previous Office Action mailed October 20, 2006, Applicants challenged the factual assertions of the Official Notice taken. The present Office Action fails to address Applicants' challenge.

The present Office Action again relies on Official Notice in order to reject claims 18-19 (see page 9) and claims 6-7, 11-12, and 14-15 (see page 14). Applicants respectfully traverse this rejection.

From the MPEP 2144.03(E): "Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. *See, for example, In re Zurko*, 258 F.3d 1379, 1386; *In re Ahlert*, 424 F.2d 1088, 1092."

Further, "[a]s noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." MPEP 2144.03 (emphasis added).

Claim 18 is representative and recites, *inter alia*:

“... said acquiring means acquires a keyword preset to said television program from a second site and second advertisement-associated data corresponding to said keyword from said first site.”

The Office Action asserts at page 9, “Official Notice is taken that it is well known in the art to acquire program information (such as keywords defining the type of program) so as to reduce traffic on any one site . . .” Applicants respectfully point out that that is **not what is recited in claim 18**.

Claim 18 depends from claim 17. Claim 17 recites, *inter alia*, “acquires first advertisement-associated data preset to said television program corresponding to said television program identifying information from a first site.” Applicants do not concede claim 17 is well-known in the art. However, claim 18 adds the additional limitation as recited above. Thus, the combination of elements recited in claims 17 and 18 require, in relevant part, acquiring from a first website the first advertisement-associated data corresponding to the television program **AND** acquiring from a second website a keyword preset to the television program **AND ALSO** acquiring from the first website second advertisement-associated data corresponding to the keyword (that was acquired from the second website).

Moreover, the second website (the keyword site) is defined in the specification. *See, for example*, Publ. App. par [0150].

“The keyword site herein denotes is a site on the network 6 which identifies a program to be recorded on the basis of the recording date and channel data received from the iEPG site 7 and transmits a program keyword (to be described with reference to FIG. 21) recorded as related to the identified program to the iEPG site and the advertisement site 8.”

The Office Action also must use Applicants’ definition of the second website when asserting Official Notice. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir.

2004) (“Claims are construed in light of the specification, of which they are a part”). *See, also*, MPEP 2101.01 and MPEP 2173.05. Thus, any Official Notice or alleged prior art must identify a second site as defined in Applicants’ specification.

Applicants contend the Office Action depends on a mere conclusory statement and an impermissible reliance on Official Notice. The Applicants contend the features of claim 18 are not of notorious character nor insubstantial, as asserted in the Office Action. Certainly, the features recited in claim 18 are not capable of “instant and unquestionable demonstration as to defy dispute.” These features are neither “basic knowledge” nor “common sense.” In *re* Lee, 277 F.3d 1338, 1345 (Fed. Cir. 2002) (“Deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense.’”). Applicants contend that claim 18 recites substantive features that can not be overcome with Official Notice.

Thus, in accordance with MPEP 2144.03(D) and so that the record of prosecution be complete, Applicants respectfully request documentary evidence under 37 C.F.R. 104(c)(2) of the elements recited in claim 18, or an affidavit of the Examiner under 37 C.F.R. 104(d)(2) setting forth specific factual statements and explanation to support the facts asserted.

IV. DEPENDENT CLAIMS

The other claims are each dependent from one of the independent claims discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

All claims are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference(s), it is respectfully requested that the Examiner specifically indicate those portion(s) of the reference(s), providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants



By: _____

Paul A. Levy
Reg. No. 45,748
(212) 588-0800